



PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 060279.00061
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 10/652,253
	Filed: September 2, 2003
	First Named Inventor: Jonas HAFREN
	Art Unit: 2617
	Examiner: Dai Phuong

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed

☒ Attorney or agent of record.
Registration No. 58,178

☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____



Signature

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Typed or printed name

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May 23, 2008

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 form is submitted (i.e. this form itself).



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Confirmation No.: 1859

Jonas HAFREN

Art Unit: 2617

Serial Number: 10/652,253

Examiner: Dai Phuong

Filed: September 12, 2003

Atty. Docket No.: 060279.00061

For: METHOD AND SYSTEM FOR CHARGING A STREAMING CONNECTION IN A
MOBILE PACKET RADIO SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 23, 2008

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the Official Gazette Notice of July 12, 2005, Applicant hereby submits this Pre-Appeal Brief Request for Review of the final rejections of claims 1-13, 15-34, 36 and 38-47 in the above identified application. Claims 1-13, 15-34, 36 and 38-47 were finally rejected in the Office Action dated January 23, 2008. Applicant filed a Response to the Final Office Action on March 24, 2008, and the Office issued an Advisory Action dated May 14, 2008 maintaining the final rejections of claims 1-13, 15-34, 36 and 38-47. Applicant hereby appeals these rejections and submit this Pre-Appeal Brief Request for Review.

Claims 1-4, 6, and 15-23 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Application Publication No. 2003/0093545 of Liu et al. ("Liu"). Applicant respectfully requests that this rejection be withdrawn as clearly erroneous.

Liu generally relates to a method and system for downloading data to a portable electronic device. More specifically, Liu discusses an arrangement for downloading data to a portable electronic device, in which the arrangement enables a terminal user to login from anywhere to a service management center through a wired (e.g. a computer device) or a wireless (e.g. a WAP telephone) network connection. This, in turn, allows the user to manage and browse e-books (and/or e.g. pictures, images, sounds, etc.), as well as to download required e-books.

As described at paragraph [0022] of Liu, an e-book file required by a user of a cellular phone 11 is divided into file sections according to transmission bandwidth, and the divided sections are converted into a displayable format of the cellular phone 11. Then, the divisions of the e-book file are transmitted in sequence. Next, as described at paragraph [0023] of Liu, the cellular phone 11 receives the divisions in stack manner, and places them into a download

storing region 110. For reading, a decoding module 111 receives the divisions from the download storing region 110 in sequence and decodes the divided e-book file. Then, the decoded e-book file is displayed by a reading platform 112.

Clear Error 1 – Office Action Failed to Consider the Proper Definition of “Streaming”

Claim 1 recites, in part, “establishing, over said established mobile packet data connection, a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source.” Liu fails to disclose or suggest at least this feature of claim 1.

The Office Action took the position that this feature is disclosed by Liu in Figure 1 and at paragraphs [0015] and [0016]. The cited passages, however, make no mention of establishing “a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source,” as recited in claim 1. Indeed, as can be seen from the discussion above, Liu fails to teach or suggest a streaming connection comprising a continuous media stream configured for real-time playback. Rather, Liu merely discloses an e-book file download that is non-streaming and not configured for real-time playback. Since all the divisions of the e-book file must be downloaded (and decoded) before the e-book file can be displayed, the playback of the e-book is non-real-time. Consequently, the connection on which the e-book file is being downloaded is non-streaming.

The well established meaning of “streaming media” or “media stream” within the art (at the time the invention was made, at the time the application was filed, and at the present time) is that the terms relate to media that is continuously received by and displayed to the end-user while it is being delivered by the provider. An e-book file that is displayed after being delivered is not “streaming media” as understood by a person of ordinary skill in the art. For example, techdictionary.com (retrieved on October 29, 2007, from <http://techdictionary.com/> using the search term “streaming”) defines “streaming” as: “Playing audio or video immediately as it is downloaded from the Internet, rather than storing it in a file on the receiving computer first. Streaming is accomplished by way of web browser plug-ins, which decompress and play the file in real time; a fast computer and fast connection are necessary.” That such an interpretation, which is the broadest reasonable interpretation of the term “streaming media” and/or “media stream,” is the correct interpretation is reinforced by the term “real-time playback,” which makes little sense unless “streaming media” and/or “media stream” is correctly understood.

The Office Action argued, in essence, that Liu discloses downloading from a streaming source as well as playback functions. Furthermore, the Office Action argued that the “encoded” and “decoded” steps are the to process data, and are well known steps in the art. The Office Action, however, appears to reflect a misunderstanding regarding the distinction raised, as the Office Action’s arguments could be taken as completely true (not admitted), and yet the distinction identified above would still exist.

As noted above, because the whole file must be downloaded before it can be viewed in or otherwise played back in Liu, therefore Liu is not discussing or disclosing real-time playback. The fact that Liu’s system does not do real-time playback, not that Liu additionally performs encoding/decoding, is the emphasis of the distinctions noted above. Claim 1, as noted above, recites “a streaming connection comprising a continuous media stream configured for real-time

playback between said subscriber and a streaming source,” which cannot correspond to Liu’s disclosure.

The Office Action’s apparent argument that Liu discloses downloading a file from a streaming source is not enough to resuscitate the rejection, because Liu clearly requires that the entire file be downloaded before playback can occur, which categorically prohibits Liu’s system from performing “real-time playback between said subscriber and a streaming source,” as recited in claim 1.

In short, the argument is not that any encoding/decoding steps prevent downloaded data from being non-streaming, but that the file (for example, an e-book file) must in Liu be downloaded completely before it can be viewed. This requirement that the whole file be downloaded before it is viewed is what causes the download data to be considered non-streaming. That is, if the data were streaming, it could be viewed/played while it is being downloaded. Applicant respectfully submits that the Office Action nowhere points out Liu’s system could view/play the data while it is being downloaded, and consequently has essentially conceded the point that Liu contains no such teaching.

Furthermore, as a matter of fact, contrary to the Office Action’s assertions, and as explained above, the service management center of Liu is not a streaming source. Liu does not refer to the service management center of Liu as a streaming source, and one of ordinary skill in the art would not consider the service management center of Liu to be a streaming source. Accordingly, claim 1 is distinguishable over Liu for at least this further reason, with respect to the features, “a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source.”

The Office Action further argued in essence that the feature, “establishing ... a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source,” recited in claim 1, is simply an intended use. This is incorrect. The feature, “establishing ... a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source,” is a step of the method of claim 1. It is the second step of the method.

The Office Action presented no reason to support its assertion that “establishing ... a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source,” is merely an intended use, and the feature is not in the preamble of the claim or phrased in terminology that would suggest it is merely an intended use. Thus, the Office Action’s position is erroneous.

The Office Action asserted that “If the prior art structure is capable of performing the intended use, then it meets the claim.” The system of Liu, however, is not capable of performing, “establishing ... a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source,” for the reasons already discussed above. Thus, even if the remainder of the Office Action’s position were correct (not admitted), the rejection still could not stand. Thus, it is respectfully requested that the rejection be withdrawn.

Clear Error 2 – Office Action Improperly Relied on Inherency

Claim 1 also recites, “establishing a mobile packet data connection for a subscriber.” Liu further fails to disclose or suggest at least this feature of claim 1, because Liu merely discloses using a WAP cellular phone. It should be understood that a WAP cellular phone does not require a packet data connection. Instead, a WAP cellular phone can utilize, for example, Short Message Service (SMS) messages. Dividing the e-book file into sections strongly suggests to an ordinarily skilled artisan that SMS messages (rather than a packet data connection) should be used (since the sections would be able to fit into SMS messages, unlike an entire e-book). See, for example, paragraphs [0004] and [0022] of Liu. Thus, there is not only no explicit disclosure or suggestion of establishing a packet data connection, the teaching of division into sections teaches away from establishing a packet data connection in favor, instead, of using SMS messages.

The Office Action argued, in essence, that Liu discloses a cellular telephone connecting to a service management center via a network communication system 2. The network communication system 2 includes a network system that includes the Internet, apparently for the provision of a data service. The Office Action asserted that “it is inherent that the connection is for mobile packet data.” Applicant respectfully disagrees with the Office Action’s assertions and conclusions.

The fact that a cellular phone can establish a connection to the Internet does not imply in any way that mobile portion of the connection is necessarily packet-switched. The conventional art at the time of Liu included, for example, established techniques, such as circuit-switched (*i.e.* non-packet data connections) cellular data connection techniques: for example, Circuit-Switched Data (CSD) and High-Speed Circuit-Switched Data (HSCSD), as well as the use of modems. CSD is the original form of data transmission developed for Time Division Multiple Access (TDMA)-based mobile phone systems, such as Global System for Mobile Communications (GSM). HSCSD is a later enhancement to CSD. These techniques were in use during the approximate time period of the late 1990’s to 2003. Considering the filing date of Liu, one of ordinary skill in the art would have understood that such non-packet data connections were intended by the disclosure of Liu.

Accordingly, it is respectfully requested that, for each of the reasons set forth above, the rejection of claim 1 be withdrawn. Although each claim has its own respective scope, the same clear errors exist with respect to the rejections of each of the rejected claims.

Clear Error 3 – Kinno is not Proper Prior Art

Additionally, with respect to the rejection of claims 7-8 and 10 under 35 U.S.C. 103(a) as being unpatentable over Liu in view of U.S. Patent Application Publication No. 2006/0048669 of Kinno et al. (“Kinno”), the rejection is clearly erroneous because Kinno is not proper prior art.

In view of Kinno’s filing date of August 25, 2005, Applicant respectfully asserts that Kinno *as U.S. Patent Application Publication No. 2006/0048669, published March 9, 2006*, is not proper prior art under 35 U.S.C. 102(e) (or any other section) because it was both filed and published after the filing date of the present application.

The Office Action argued that Kinno is being cited under 35 U.S.C. 103, not 35 U.S.C. 102(e). The only way, however, that a reference is a valid reference under 35 U.S.C. 103, is if it is a citable reference under one or more subsection of 35 U.S.C. 102. 35 U.S.C. 103(a) relaxes the content requirements, it does not relax the date requirements, and does not provide for later-filed references to be considered prior art. Since, as the Office Action appears to have conceded, Kinno is not citable (based on its filing and/or publication dates) under any subsection of 35 U.S.C. 102, it is also not citable under 35 U.S.C. 103.

The Office Action also made reference to U.S. Patent Application Serial Number 10/359,662 (the '662 application), which was filed (according to the Office Action) on February 7, 2003. No publication of the '662 application or patent issued on the '662 application, however, has been cited in the rejection. 35 U.S.C. 102(e) provides no provision for the consideration of priority dates beyond the international filing dates of certain PCT applications filed under 35 U.S.C. 371, which is not germane to Kinno. Thus, even if Kinno were to properly claim the priority of the '662 application (not admitted), that would not make the filing date of Kinno under 35 U.S.C. 102(e) any earlier. Thus, the rejection is clearly erroneous and should be withdrawn.

Thus, it has been demonstrated that each of the rejections is clearly erroneous and cannot be maintained. The comments provided in the Advisory Action, especially the comment that "The Examiner suggests the Applicant to [sic] read the while [sic] reference in order to see why the reference still reads on the claim language," do nothing to remove the clear errors identified above. Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: PTO/SB/33 Form; Notice of Appeal; Petition for Extension of Time;

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